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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/678,062	10/02/2000	Raymond W. Coles	ULTRA-1001	4462

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EXAMINER

FUREMAN, JARED

ART UNIT PAPER NUMBER

2876

DATE MAILED: 05/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/678,062

Applicant(s)

COLES, RAYMOND W.

Examiner

Jared J. Fureman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 February 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 October 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Receipt is acknowledged of the extension of time, power of attorney, and amendment, filed on 2/28/2003, which have been entered in the file. Claims 1-20 are pending.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-11 and 15-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baxendale (US 5,990,918, previously cited) in view of Lyszczarz (US 4,897,533, previously cited).

Baxendale teaches a method of forming an image and a printed item comprising: providing a layer of plastics material (7) over a substrate (4), and selectively altering the optical properties of portions (7' or 10) of the plastics material so as to form an image therein, wherein the layer of plastics material is provided on a carrier film (see column 3 lines 8-13) and in which a plurality of heater elements (5) are provided on a thermal print head (1), and in which the heater elements are energized when the carrier film is in contact with the substrate to transfer the plastics material to the substrate (see column 3 lines 8-23), wherein the heater elements are energized to deposit a continuous layer of the plastics material over the whole of the area to be covered such that the plastics material serves as a protective coating (see column 2 lines 4-6 and column 3 lines 8-

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17), wherein selected regions (7' or 10) of the plastics material are heated to a greater degree than other areas so as to vary the surface appearance of the plastics layer (see column 3 lines 13-27), wherein the full thickness of the plastics film is deposited and selected portions thereof are overheated so as to give these portions a different appearance (see column 2 lines 31-35 and column 3 lines 28-40), wherein the overheated portions have a satin appearance (see column 2 lines 31-35 and column 3 lines 28-40), wherein the overheated portions have a matt appearance (see column 2 lines 31-35 and column 3 lines 28-40), wherein the image is printed over the substrate in a repeating pattern (as seen in figures 3 and 4, the regions 7' and 10 are formed in a repeating pattern), a surface printed in accordance with the method (the surface of the plastics material 7), wherein the layer of plastics material is deposited on the substrate during a printing process (the plastics material is deposited using printhead 1), wherein the item is an identity card, bank card, or credit card (see figures 1-4, column 1 line 10 - column 2 line 35, column 2 line 66 - column 3 line 40).

Baxendale fails to teach the substrate having at least one reflective region thereon, the reflective region comprising a metal film, wherein the metal film is printed onto the substrate, wherein the metal film is provided on a carrier film and is brought into contact with the substrate at a printing station and transferred to the substrate.

Lyszczarz teaches a method and an item comprising: providing a layer of plastics material (4) over a substrate (2), the substrate having at least one reflective region (3) thereon, wherein the metal film is printed onto the substrate (the heat transfer of the foil 3 can be considered printing), wherein the metal film is provided on a carrier film (see

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column 4 lines 44-48) and is brought into contact with the substrate at a printing station (not shown, see column 4 line 41 - column 5 line 8) and transferred to the substrate (see figure 1-3, 5, 6, column 1 lines 13-19, column 1 line 57 - column 2 line 20, column 2 line 53 - column 3 line 6, column 3 lines 31-56, column 4 lines 1-10, column 4 line 41 - column 5 line 16, and column 5 lines 29-43).

In view of Lyszczarz's teachings, it would have been obvious to one of ordinary skill in the art at the time of the invention to include, with the system as taught by Baxendale, the substrate having at least one reflective region thereon, wherein the metal film is printed onto the substrate, wherein the metal film is provided on a carrier film and is brought into contact with the substrate at a printing station and transferred to the substrate, in order to provide an attractive, distinctive appearance (see column 1 lines 12-24 and 43-51).

3. Claims 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baxendale as modified by Lyszczarz as applied to claim 1 above, and further in view of Peyret (US 5,688,056, previously cited).

Baxendale as modified by Lyszczarz fails to specifically teach the image to be formed in the plastics film being held in a memory device readable by the printer, wherein the memory device is a removable memory device, wherein the image is held in an encrypted form.

Peyret teaches a system and method wherein an image (security mark) to be printed is held in a memory device (cartridge 104) readable by a printer (102), wherein the memory device is a removable memory device, wherein the image is held in an

encrypted form (see figures 1, 2, column 3 lines 53-60, column 4 lines 15-21, 40-43, column 5 lines 16-33).

In view of Peyret's teachings, it would have been obvious to one of ordinary skill in the art at the time of the invention to include, with the system as taught by Baxendale as modified by Lyszczarz, the image to be formed in the plastics film being held in a memory device readable by the printer, wherein the memory device is a removable memory device, wherein the image is held in an encrypted form, in order to provide greater security, thereby helping prevent fraudulent printing of the image.

Response to Arguments

4. Applicant's arguments filed 2/28/2003 have been fully considered but they are not persuasive.

In response to applicant's argument that Baxendale and Lyszczarz fail to teach or even suggest, alone or in combination, "the substrate having at least one reflective region thereon, and selectively altering optical properties of the plastics material so as to form an image therein" (see page 5 of the amendment filed on 2/28/2003), as discussed above, Baxendale teaches a substrate 4 having a plastics material 7 in which the optical properties of the plastics material are selectively altered in areas 7' or 10 (see, at least, figures 3 and 4, column 3 lines 8-40). Lyszczarz teaches a substrate 2 having at least one reflective region 3 thereon, and a plastics layer 4 over the substrate and reflective region (see, at least, figure 3 and column 3 lines 30-56). Thus, Baxendale and Lyszczarz, in combination, do teach, "the substrate having at least one

reflective region thereon, and selectively altering optical properties of the plastics material so as to form an image therein".

In response to applicant's argument that there is no suggestion to combine the references (see page 5 of the amendment filed on 2/28/2003), the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Lyszczarz teaches that the purpose for providing a reflective region 3 is to provide a card with an attractive, distinctive appearance to identify and promote the company or other entity issuing the cards (see column 1 lines 12-24 and 43-51).

In response to applicant's argument that Baxendale and Lyszczarz fail to teach or even suggest, alone or in combination, "optical properties of the plastics layer altered in at least the region overlying the reflective element" (see page 5 of the amendment filed on 2/28/2003), Baxendale teaches altering optical properties of the plastics layer 7 in a region 7' or 10 overlying the substrate 4 (see, at least, figures 3 and 4, column 3 lines 8-40). Lyszczarz teaches a reflective element 3 placed on a substrate 2, and a plastics layer 4 overlying the reflective element (see, at least, figure 3 and column 3 lines 30-56). As shown in figure 3, of Lyszczarz, the reflective element 3 covers the entire front of the substrate 2. Thus, since Baxendale teaches the regions 7' or 10

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having the altered optical properties being provided in the plastics layer 7, and Lyszczarz teaches the reflective element 3 covering the substrate 4, when combined, the regions 7' or 10 will naturally overlay the reflective element 3, since the reflective element 3 covers the entire front of the substrate. Thus, the combined teachings of Baxendale and Lyszczarz suggest, "optical properties of the plastics layer altered in at least the region overlying the reflective element".

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jared J. Fureman whose telephone number is (703) 305-0424. The examiner can normally be reached on 7:00 am - 4:30 PM M-T, and every other Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (703) 305-3503. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

Jared J. Fureman
Jared J. Fureman
May 6, 2003